

TRANSMITTAL OF APPEAL BRIEF (Small Entity)

Docket No.

1442.033B

In Re Application Of: Gardenier, et al.

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
10/621,749	July 17, 2003	PHILLIPS, Charles E.	23405	3751	1803

Invention: SOUND SYSTEM AND A HEAD REST FOR A SPA AND A SPA HAVING A SOUND SYSTEM

COMMISSIONER FOR PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

February 18, 2008

☒ Applicant claims small entity status. See 37 CFR 1.27

The fee for filing this Appeal Brief is: \$255.00

☐ A check in the amount of the fee is enclosed.☐ The Director has already been authorized to charge fees in this application to a Deposit Account.☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 081935. I have enclosed a duplicate copy of this sheet.☐ Payment by credit card. Form PTO-2038 is attached.**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**
Signature

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Dated: April 18, 2008

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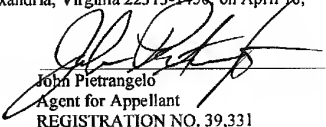
Appellant: Gardenier, et al. Confirmation No.: 1803
Serial No.: 10/621,749 Group Art Unit: 3751
Filed: July 17, 2003 Examiner: Phillips, Charles E.
Title: SOUND SYSTEM AND A HEAD REST FOR A SPA AND

A SPA HAVING A SOUND SYSTEM

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John Pietrangelo
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Date of Signature: April 18, 2008

To: Mail Stop Appeal Briefs – Patents
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Dear Sir:

**APPELLANT'S APPEAL BRIEF TO THE BOARD OF
PATENT APPEALS AND INTERFERENCES**

The Appellant is appealing a Final Rejection dated September 19, 2007. This Final Rejection rejected claims 65, 66, 68-70, 73, 74, 77, 80, 84, 85, and 92-94, that is, all the claims being considered in the above-identified application. A Notice of Appeal, with payment

Appellant: Gardenier, et al.
Appln. Serial No.: 10/621,749
Date of Appeal Brief: April 18, 2008

-2-

Attorney Ref.: 1442.033B

therefor, was timely electronically filed on February 18, 2008, and was received in the U.S. Patent and Trademark Office on February 18, 2008. Pursuant to 37 C.F.R. 41.37(a)(1), the due date for filing this Appeal Brief is April 18, 2008. This Brief is accompanied by a transmittal letter authorizing the charging of Appellant's Deposit Account for payment of the requisite fee set forth in 37 C.F.R. §41.20(b)(2).

REAL PARTY IN INTEREST

The real party in interest is Saratoga Spa & Bath, Inc. having offices in Latham, New York.

This application is assigned to Saratoga Spa & Bath, Inc. by virtue of an assignment executed by the two inventors on April 2, 2004 for application 10/621,749, and recorded with the United States Patent and Trademark Office on reel 015314, frame 0506, on May 11, 2004.

RELATED APPEALS AND INTERFERENCES

To the knowledge of Appellant, Appellant's undersigned legal representative and the assignee, there are no other appeals or interferences that will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

STATUS OF CLAIMS

The patent application under appeal was filed with the U.S. Patent and Trademark Office on July 15, 2004 as a divisional application of then co-pending application 10/268,371, now U.S.

Patent 6,763,532, filed on October 10, 2002, which is a continuation-in-part application of application 09/834,260 filed on April 12, 2001, now U.S. Patent 6,467,103.

As filed, the application included a preliminary amendment reciting 22 new claims, of which 3 claims were independent claims (that is, claims 1, 11, and 16 were independent claims).

On May 26, 2004, a Restriction Notice was mailed that included a restriction of claims 1-22 and a request to renumber claims 1-22 to claims 21-42. In a response filed on June 24, 2004, the Appellant responded to the restriction with traverse. In compliance with the request of the Patent Office, the Appellant renumbered claims 1-22 as claims 21-42. The Appellant amended claims 22-30 to reflect the renumbering of the claims, canceled claims 31-42, and introduced new claims 43-51, which are ultimately dependent upon claim 21. The Appellant also elected Figure 9 as the elected species. Claims 21-30 and 42-51 were then pending.

On September 14, 2004, a First Office Action was mailed that included a rejection of claims 21, 23, 24, 26, 29, and 43-48 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 4,715,546, of Kvalvik [herein "Kvalvik"]. In addition, claims 22, 25, 27, 28, and 30 were rejected under 35 U.S.C. §103(a) as obvious in view of Kvalvik. Also, claims 21-30 and 43-48 were rejected under 35 U.S.C. 103(a) as obvious in view of U.S. Patent 4,575,882 of Diamond [herein "Diamond"] and Kvalvik. The Patent Office also withdrew claims 49-51 as being drawn to a non-elected species of Figure 9.

In response to this Office Action, Appellant filed a Response to Office Action on December 14, 2004 in which no claims were amended and arguments over the cited art and the withdrawal were presented. Claims 21-30 and 43-51 remained pending.

On April 8, 2005, a Second Office Action, made Final, was mailed that included a rejection of claims 21-30 and 43-48 as anticipated and/or obvious in view of Kvalvik or obvious in view of Kvalvik and Diamond. The Office Action also included a withdrawal of claims 49-51.

On July 8, 2005, the Appellant filed a Request for Continued Examination (RCE) and Amendment in response to the Final Office Action. In this Amendment, the Appellant cancelled claims 21-40 and 43-51, and introduced new claims 52-64.

In response to the above RCE/Amendment, on August 26, 2005, the Patent Office mailed a Communication in which the Patent Office deemed the Response filed on July 8, 2005 not fully responsive to the prior Office Action because of the following omissions:

- (1) the reply fails to comply with section (b) of 37 CFR 1.111; and
- (2) the reply is silent with respect to the election of species of the newly presented claims.

Since the Appellant was unclear of the Patent Office's request in the Communication, on September 29, 2005, the Appellant's undersigned Agent contacted Examiner Charles Phillips by phone and discussed with Mr. Phillips the Appellant's intent to reintroduce the claims submitted with the response filed on December 14, 2004 for consideration.

In response to the Communication and the phone conversation, on October 24, 2005, the Appellant filed a Supplemental Response to Office Action which supplemented the

RCE/Amendment filed on July 8, 2005 and addressed the objections that appeared in the Communication of September 29, 2005. Specifically, in this Response the Appellant cancelled claims 52-64 and introduced new claims 65-83. Claims 65-83 that were introduced corresponded to previously pending claims 21-30 and 43-52, with amendment, submitted on December 14, 2004. Claims 65-83 were then pending in this application.

On December 6, 2005, in response to the above Supplemental Response, the Patent Office mailed a Communication in which the Patent Office deemed the Response filed on July 8, 2005 not fully responsive to the prior Office Action.

On December 22, 2005, in response to the above Communication, the Appellant filed an Amendment/ Response cancelling claims 81-83 and explicitly electing the species of Figure 9. Claims 65-80 were then pending in this application.

On February 3, 2006, the Patent Office mailed a non-Final Office Action rejecting claims 65-72 and 74-80 as obvious in view of U.S. Patent 5,754,989 of Ludlow (herein "Ludlow") and Kvalvik, and withdrawing claim 73 as not drawn to the elected species of Figure 9.

On May 2, 2006, in response to the above Office Action, the Appellant filed a Response without claim amendment addressing the rejections in the Office Action. Claims 65-80 remained pending in this application.

On June 8, 2006, the Patent Office mailed an Office Action made Final again rejecting claims 65-72 and 74-80 as obvious in view of Ludlow and Kvalvik, and again withdrawing claim 73 as not drawn to the elected species of Figure 9.

On October 9, 2006, in response to the above Office Action made Final, the Appellant filed an RCE/Amendment/Response amending claim 65, cancelling claims 67, 71, 72, 75, 76, 78, and 79, and introduced new claims 85-93. Claims 65, 66, 68-70, 73, 74, 77, 80, and 85-93 were then pending in this application.

On November 30, 2006, in response to the above RCE/Amendment/Response, the Patent Office mailed a Communication in which the Patent Office deemed the Response filed on October 9, 2006 not fully responsive to the prior Office Action.

On January 2, 2007, in response to the above Communication, the Appellant filed an Amendment/Response amending the numbering of claims 85-93 to claim numbers 84-92 to address an oversight identified in the above Communication. Claims 65, 66, 68-70, 73, 74, 77, 80, and 84-92 were then pending in this application.

On February 23, 2007, the Patent Office mailed a Notice of Non-compliant Amendment in which the Patent Office requested the previous amendment be corrected by striking through the amended claim number.

On March 13, 2007, the Appellant filed a Response to the above Notice of Non-compliant Amendment with strike-throughs and renumbering of claims 85-93 to claim numbers 84-92. Claims 65, 66, 68-70, 73, 74, 77, 80, and 84-92 remained pending in this application.

On May 2, 2007, the Patent Office mailed a non-Final Office Action again rejecting claims "65-92" [actually, only claims 65, 66, 68-70, 73, 74, 77, 80, and 84-92] pursuant to 35 U.S. 112 for filing to comply with the enablement requirement, and rejected claims 65, 68, 70, 71, 74, 77, 80, 87, and 92 as obvious in view of Ludlow and Kvalvik. The Patent Office also rejected claims 66, 69, and 72 as obvious in view of Ludlow, Kvalvik, and Diamond.

On July 27, 2007, the Appellant filed a Response to the above Office Action with Amendment amending claims 65, 84, 85, and 92; canceling claims 86-91; and introducing new claims 93 and 94. Claims 65, 66, 68-70, 73, 74, 77, 80, 84, 85, and 92-94 were then pending in this application.

On September 19, 2007, the Patent Office mailed a Office Action made Final again rejecting claims 65, 66, 68-70, 74, 77, 80, and 92-94 pursuant to 35 U.S. 112 for filing to comply with the enablement requirement, and rejecting claims 65, 68, 70, 74, 77, 80, 87, and 92-94 as obvious in view of Ludlow and Kvalvik. The Patent Office also rejected claims 66 and 69 as

obvious in view of Ludlow, Kvalvik, and Diamond. The Patent Office also withdrew claims 73, 84, and 85 as being drawn to a non-elected species.

On January 22, 2008, the Appellant filed a Response after Final to the above Office Action made Final with Amendment amending claim 65 to overcome the §112 rejections. Claims 65, 66, 68-70, 73, 74, 77, 80, 84, 85, and 92-94 remained pending in this application.

On February 4, 2008, the Patent Office mailed an Advisory Action entering the amendment above and acknowledging that the amendment to claim 65 overcame the §112 rejections and maintaining the rejections of claims 65, 66, 68, 69, 70, 74, 77, 80, 87, and 92-94 as obvious in view of Ludlow, Kvalvik, and Diamond.

On February 18, 2008, the Appellant timely filed the above-referenced Notice of Appeal to the Office Action made Final mailed on September 19, 2007.

Therefore, the status of the claims is as follows:

Claims allowed – None.

Claims objected to – None.

Claims rejected – 65, 66, 68-70, 73, 74, 77, 80, 84, 85, and 92-94; and

Claims canceled – 1-64, 67, 71, 72, 75, 76, 78, 79, 81-83, and 86-91.

Appellants are appealing the rejection of claims 65, 66, 68-70, 73, 74, 77, 80, 84, 85, and 92-94, with the following claim being argued: 65

STATUS OF AMENDMENTS

No amendments were filed after the Advisory Action dated February 4, 2008.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 65 recites a “sound system for a spa,” for example, for a hot tub, that includes a “head rest” having at least one “sound emitting perforation” and at least one “electronic speaker” positioned to transmit sound through the at least one perforation in the head rest. This aspect of the invention is most clearly illustrated, for example, in Figures 8 and 9 of the instant application. However, Figures 8 and 9 are representative, and do not illustrate all the aspects of the invention which Figures 8 and 9 illustrate.

The invention recited in claim 65, and as shown, for example, in Figures 8 and 9, includes the “sound system for a spa” having a “head rest...having at least one sound emitting perforation” and a “at least one “electronic speaker...positioned to transmit sound through the at least one sound emitting perforation.” Figures 8 and 9 of the instant application display a head rest 229 (misidentified 129 in Figure 8) and speakers 244. Figures 8 and 9 are provided to illustrate representative aspects of the invention, and are not intended to limit the invention. For example, in paragraphs [0061] and [0062], the inventors disclose that in Figures 8 and 9, “Head rest 229 also includes at least one, typically two, electronic or wave-guide-type speakers 244 as discussed previously.” [0061: lines 7-9] and “The speaker 224 in this aspect can be an electronic speaker or a wave-guide-type speaker as discussed above...” [0062:6-8]. [In the above discussion and throughout this Brief, in order to facilitate the Board’s review, reference is made to the paragraphs and line numbers of the as-filed application as they appear in published application 2004/0016051 A1.] One of those previous discussions referenced in these passages is presented in paragraph [0050] where the inventors disclose, with respect to Figures 4A, 4B,

5A, and 5B, "...according to one aspect of the present invention, an electronic speaker may be located directly beneath or adjacent to speakers 42, 44, or, for example, positioned within the head rest 29[,] and emit audio sound waves that are transmitted by wave guides 58, 60 or wires and still be within the scope of the present invention." [0050:8-13] As shown, for example, in Figures 4B and 5B, wave guides 58 and 60 transmit sound to perforations 74 and 76 (misabeled 73, 75 in Figure 4B) in head rests 29 and 129.

However, as recited in claim 65, the sound system for a spa according to the invention is not simply limited to a headrest and an electronic speaker. As recited in claim 65 and discussed in the instant specification, the invention includes certain features that are not found in the prior art and are advantageous compared to the prior art. First, the spa for which the invention is adapted typically includes "a housing having an upper rim of substantially uniform elevation," and the head rest of the invention is "mounted on or below the upper rim so as not to substantially alter the substantially uniform elevation." Second, according to the invention, the electronic speaker is "located below the upper rim of the housing." The reason and advantages of these limitations will be apparent from the discussion below.

As described in the specification under the heading "Background Art," specifically in paragraphs [0004] through [0008], the introduction of electronic speakers to spas and related structures in the prior art is characterized by positioning the electronic speakers as high as possible in the spa to avoid electrical hazard of potential contact with the water in the spa. Kvalvik is one example of such a prior art teaching of positioning an electrical speaker high in the spa housing, which, compared to the present invention, is undesirable. However, as

described in paragraphs [0006] through [0008], the positioning of electronic speakers high in the spa housing has undesirable impacts upon the manufacture of the spa housing, the retro-fitting of existing spa housings with speakers, and the storing, packaging and shipping requirements of the spa when speakers are introduced.

For example, as described in paragraph [0006], when speakers are mounted high in the spa, for example, above the nominal height of the spa housing, special accommodations must be made in the housing to accommodate the speaker mounting. This typically entails the introduction of “extensions” to the spa housing that is undesirable when manufacturing spas. For instance, spa housings are typically provided as one-piece, plastic constructions molded, for example, from a thermoplastic. According to the existing art, in order to introduce extensions to accommodate speakers positioned above the nominal height of the housing, either the housing molds must be modified or premolded housings must be mounted to the existing mold housings – both of these options add undesirable time and cost to the manufacturing process. The claimed invention avoids this disadvantage of existing practice by, among other things, not “substantially alter[ing] the substantially uniform elevation” and positioning the electronic speaker “below the upper rim of the housing” whereby the existing housing molds and molding dies can be used when providing speakers to a spa. That is, the invention facilitates the manufacturing process.

In addition, as described in paragraph [0007], when speakers are mounted high in the spa, the retrofitting of speakers to existing spa housings is hampered, if not prevented all together. For example, existing spa housings without accommodations for speakers, for example, as evidenced by Kvalvik, are more difficult to modify to accept speakers mounted above the

nominal height of the housing without making cumbersome and costly modifications to the housing. By mounting the head rest and speaker “as not to substantially alter the substantially uniform elevation” of the spa, audio speakers can be introduced to existing spas at nominal cost and little or no modification to the spa housing. Compared to the prior art, the invention facilitates retrofitting existing spa housings with electronic speakers.

Moreover, as described in paragraph [0008], the invention minimizes the impact of introducing electronic speakers to spas upon storing, packaging, and shipping. As is typical in the art, spa tub sections, prior to assembly, are stored, packaged, and shipped nested within similar spa tub sections, that is, one molded tub section is inserted into another molded tub section to provide a nested collection of tub sections that can be more conveniently stored, packaged, and shipped. However, according to the existing art, for example, as evidenced by Kvalvik, when speakers are mounted high in the spa, that is, above the nominal height of the spa housing, the nesting of tub sections is either prevented or the nominal height of the nested sections must increase to accommodate the extensions for the speaker. This increase in height according to the prior art impacts the volume and cost of storing, packaging, and shipping of spas so modified. Again, by mounting the head rest and speaker “as not to substantially alter the substantially uniform elevation” of the spa, according to the present invention, audio speakers can be introduced to spas with little or no impact upon storing, packaging, and shipping of spas.

According to the invention, by mounting the head rest “on or below the upper rim so as not to substantially alter the substantially uniform elevation” and locating the electronic speaker

“below the upper rim of the housing” the undesirable negative impacts upon the manufacturing, retro-fitting, and storing, packing, and shipping are avoided.

As shown in Figures 8 and 9 of the instant application, the inventors avoid these negative impacts upon the spa housing by positioning the head rest “on or below the upper rim [224] of the housing” and positioning the speaker 244 “below the upper rim [224] of the housing.” The Appellant submits that these features of the present invention are not disclosed, taught, suggested, or in anyway “common sense” in view of the cited art.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. The Office Action made Final, mailed September 9, 2007, rejected claims 65, 68, 70, 74, 77, 80, 87, and 92-94 under 35 U.S.C. §103(a) as allegedly being obvious in view of Ludlow and Kvalvik.
2. The Office Action made Final also rejected claims 66 and 69 under 35 U.S.C. §103(a) as allegedly being obvious in view of Ludlow, Kvalvik, and Diamond.
3. The Office Action made Final also withdrew claims 73, 84, and 85 as being drawn to a non-elected invention.

ARGUMENT

1. Response to Rejection under 35 U.S.C. §103 as obvious in view of Ludlow and Kvalvik

Claims: 65, 68, 70, 74, 77, 80, 87, and 92-94:

Claims 65, 68, 70, 74, 77, 80, 87, and 92-94 stand rejected under 35 U.S.C. §103(a) as obvious in view of Ludlow and Kvalvik. The Appellant respectfully submits that the rejection of these claims is inappropriate and respectfully requests reversal of these rejections for at least the reasons set forth below.

With respect to this obviousness rejection, recent Supreme Court rulings are helpful.

KSR and Graham and "Obviousness"

In response to the recent Supreme Court decision in *KSR v. Teleflex, Inc.*, the USPTO updated section 2141 of the MPEP to provide some guidance when considering an obviousness rejection under 35 U.S.C. 103. Specifically, section 2141 underscores the continued significance the *KSR* decision ascribes to the *Graham v. Deere* inquiries, that is,

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the claimed invention and the prior art; and
- (C) Resolving the level of ordinary skill in the pertinent art.

Section 2141 then summarizes:

The question of obviousness must be resolved on the basis of these factual determinations. While each case is different and must be decided on its own facts, the *Graham* factors, including secondary considerations when present, are the controlling inquiries in any obviousness analysis.

and

In short, the focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and on what such a person would have reasonably expected to have been able to do in view of that knowledge. This is so regardless of whether the source of that knowledge and ability was documentary prior art, general knowledge in the art, or common sense. [Emphasis added.]

But, as noted in section 2141, the Supreme Court cautions that there must be "clear articulation of the reason(s) why the claimed invention would have been obvious."

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. [Emphasis added.]

The Appellant submits that the Supreme Court's advisories, as articulated in the MPEP, are particularly applicable to the present rejections under §103(a). In particular, the Appellant submits that there is no "apparent reason" to combine the teachings of the cited references. Furthermore, the Patent Office has not provided any "explicit" reasons for combining the teachings of the references, as promulgated by the Supreme Court's instructions.

Response to 103 “Obviousness” Rejection of Claim 65

With respect to the rejection of claim 65 as obvious in view of Ludlow and Kvalvik, in the Office Action made Final, the Patent Office states,

the showing of the use of a speaker in a head rest of a spa, such as Kvalvik, to employ a speaker in the head rest of an identical art device such as taught by Ludlow would have been in the arena of the KSR discussion of th[e] application of “common sense.”

However, the Appellant submits that, contrary to the Patent Office’s statement, and notwithstanding the above discussion of *KSR* and *Graham*, the intricacies of deciphering the teachings of the prior art and the obviousness of the invention need not even be considered. The Appellant submits that, even when combined, the teachings of the invention recited in claim 65 are not provided.

Though not stated in the Office Action made Final, in prior actions the Patent Office relies on Ludlow to teach that a “cushion or pillow” 175 in Figure 5 of Ludlow can be mounted on the upper rim of a spa 101. However, since Ludlow is silent with respect to the claimed electronic speaker, the Patent Office relies on the teachings of Kvalvik to provide this teaching. As shown in Figure 2, Kvalvik discloses audio equipment “A” mounted beneath a headrest 30 of a tub cushion 10 mounted in a tub “T.” However, this proposed combination by the Patent Office not only fails to recognize the incompatibility of the combination of the teachings of these references, but even when the teachings of these references are combined the claimed invention does not ensue.

As recited claim 65, and discussed above, the claimed sound system includes a head rest mounted “so as not to substantially alter the substantially uniform elevation” of the housing of the spa. As discussed in the present specification, and revisited above, undesirable modifications to the housing by the headrest can not only provide an unpleasing visual obstruction, but can interfere with or negatively impact the manufacture, retrofitting, and packaging and shipping

requirements for a spa housing - housings which are typically packed and shipped in a nested fashion, that is, one inside the other. Though the spa of Ludlow may exhibit a desirable, relatively uniform housing rim elevation, even if one could introduce the electronic component of Kvalvik to the head rest of Ludlow (for example, by some undisclosed or unsuggested modification to the housing of Ludlow), the relatively uniform elevation of the Ludlow spa would have to be sacrificed. That is, the combination of Ludlow and Kvalvik does not disclose or make obvious providing a sound system having a head rest and a speaker to a spa "so as to not substantially alter the substantially uniform elevation" of the housing of the spa, as claimed. Though the Patent Office states in the Office Action made Final, "there is no evidence that the position of the Ludlow head rest would 'have to be sacrificed,'" the Appellant submits the following.

As shown in Kvalvik, audio equipment A is mounted adjacent the ear of the bather in a head rest 30 that clearly "alters the elevation" of spa liner 10. That is, typical of other prior art spas, the tub liner of Kvalvik cannot accommodate the audio equipment of Kvalvik without interfering with the shape of the liner and, contrary to the claimed invention, "substantially alter[s] the substantially uniform elevation" of the spa housing. The Appellant submits that simply combining this Kvalvik audio equipment mounting with the head rest of Ludlow will inherently "substantially alter the substantially uniform elevation" of Ludlow. Thus, the combination of Ludlow and Kvalvik, even when combined, does not provide the features of the claimed invention. For this reason alone, the Appellant submits that the invention recited in claim 65 is not obvious in view of Ludlow and Kvalvik.

Further, the invention recited in claim 65 is also not obvious in view of Ludlow and Kvalvik due to the incompatibility of Kvalvik with Ludlow, and the undesirable effect upon Ludlow of introducing the teachings of Kvalvik. This requires a close examination of Ludlow.

As described by its title and abstract, Ludlow discloses a "plumbing" or "water distribution system" for a spa. As shown most clearly in Figures 3, 4, and 5 of Ludlow, the system disclosed by Ludlow includes a plurality of "manifolds" 139 mounted behind each seat of the spa. As shown in Figure 3, these manifolds 139 are mounted behind every seat or "pod" 137

that appears in the Ludlow spa. As shown in Figures 4 and 5, and described at 5:10-55, these manifolds 139 supply water to the water jets 115 in each pod 137. As shown most clearly in Figure 5 of Ludlow, the manifolds 139 are mounted directly beneath cushion 175. The Appellant submits that, not only is there no suggestion or teaching in Ludlow to provide a speaker in the headrest 175, but the placement of such a speaker taught by Kvalvik beneath the cushion 175 would, barring some significant, undisclosed redesign of Ludlow, either interferes with the manifolds 139 (that is, manifolds that characterize the very invention disclosed by Ludlow) or requires the cushion 175 be modified to accommodate a speaker. Due to the presence of the invention of Ludlow, that is, the manifold 139, there is simply no room for audio equipment A of Kvalvik beneath the head rests of Ludlow and, should a speaker be introduced to Ludlow, some form of undisclosed and unsuggested modification to the housing or head rest of Ludlow must be provided. Further, the Appellant submits that should the undisclosed modification of cushion 175 be introduced to accommodate a speaker, this modification will inherently alter the height of cushion 175 whereby, contrary to the invention, the speaker would be positioned above the housing rim. Failing to provide such motivation, teaching, or even physical space for such a modification, the Appellant respectfully submits that the invention recited in claim 65 is not obvious in view of Ludlow and Kvalvik. Again, the Appellant requests that this rejection be reconsidered and reversed:

Moreover, as shown in Figure 5, the cavity beneath cushion 175 of Ludlow is exposed to water level 195. As shown in Figure 5 of Ludlow, the cavity behind cushion 175 of Ludlow is within the water envelope of spa 101. That is, without some form of modification to Ludlow, the audio equipment A will undesirably be exposed to the water level 195 of Ludlow. According to the teachings of Kvalvik, for example, at 5:48-53, this is undesirable.

Preferably the audio equipment A is battery powered, to reduce electric shock hazard, but the placement of the audio device A high in the head rest 30, with the closure 34, speaker grill seal 40, and drain passage 42, serve to make insignificant any slight hazard which might otherwise occur. [5:48-53, Emphasis added.]

Clearly, Kvalvik takes great pains to minimize or prevent electric shock due to introducing an electrical device to a water environment. However, the proposed introduction by the Patent Office of audio equipment A beneath cushion 175 of Ludlow completely disregards and is counter to the teachings of Kvalvik. This distinction also underscores the incompatibility of the teachings of Ludlow and Kvalvik whereby the claimed invention is not obvious. Again, the Appellant requests that this rejection be reconsidered and reversed.

Further still, the Appellant submits that, even when combined, there is no teaching, motivation, or suggestion in Ludlow or in Kvalvik to provide an electronic speaker "located below the upper rim of the housing" as claimed. In the Office Action made Final, the Patent Office states "an introduction of a speaker to Ludlow would certainly be 'located below the upper rim of the housing' because his [assume Ludlow's] cushion resides there.'" Though the reasoning behind this assertion is unclear, the Appellant submits that, contrary to the Patent Office's statements, Ludlow can't accommodate the electrical equipment, and Ludlow teaches away from introducing the claimed speaker of Kvalvik. Even if Ludlow could accept the equipment of Kvalvik, contrary to the claimed invention, the speaker could only be located above the rim of the housing.

Referring again to the audio equipment A of Kvalvik shown in Figure 2 of Kvalvik, contrary to the claimed invention, equipment A is clearly not located below the upper rim of the housing as claimed, but mounted on top of the housing. As noted above, contrary to the claimed invention, Kvalvik teaches that equipment A be located above the rim of liner 10 to prevent electric shock. In contrast, the present invention does not locate the electric speaker above the housing rim to avoid modifications to the housing, which would negatively impact the manufacturing, retro-fitting, and the packaging and shipping requirements of the spa housing. Of course, Ludlow does not disclose the placement of any speakers. The Appellant submits the cited art does not disclose, teach, or suggest that locating a speaker below the upper rim of a spa, and for this reason alone, the invention recited in claim 65 is not obvious in view of Ludlow and Kvalvik.

In addition, the specification of Ludlow provides further evidence that the invention recited in claim 65 is not obvious in view of Ludlow and Kvalvik. In column 4, lines 22-43, Ludlow explains how the placement of supply lines 129 in channels 131 (see Figures 3 and 4) which supply manifolds 139 are preferably positioned above the “water line” 195 whereby any water in channel 131 “flows into the containment 105” (4:32). That is, Ludlow teaches that the elevation of supply lines 129 in channels 131, and thus the elevation of manifolds 139 behind headrests 175, is preferred to ensure the desired draining. This characteristic of the Ludlow system is summarized in lines 64-66 of column 4, where Ludlow summarizes one advantage of his invention as:

2) having the supply lines in covered channels, hollows, or chambers that are disposed such that water will drain or flow into the containment. [Emphasis added.]

That is, Ludlow discloses that the placement of manifolds 139 higher in the tub housing, and inherently behind the headrest, is one advantage of the Ludlow invention. The Appellant submits that locating the electronic equipment of Kvalvik at the same location as proposed by the Patent Office would either interfere with this desired feature of Ludlow, or require the speakers to be above the manifolds 139 which would, contrary to the present invention, inherently “substantially alter the substantially uniform elevation” of the rim of the spa housing. Again, the Appellant submits that this provides further evidence that the invention recited in claim 65 is not obvious in view of Ludlow and Kvalvik.

For all these reasons, the Appellant submits that even when combined the invention recited in claim 65 does not ensue. Moreover, in contradiction of the Supreme Court’s advisories, as articulated in the MPEP, there is no “apparent reason” to combine the teachings of Ludlow and Kvalvik to provide the invention recited in claim 65. Again, the Appellant submits that the rejection of claim 65 as obvious in view of Ludlow and Kvalvik is untenable, and should be reversed.

With respect to the rejections of dependent claims 68, 70, 74, 77, 80, 87, and 92-94, the Appellant submits that these claims are not obvious in view of Ludlow and Kvalvik for the same

reasons that claim 65, from which they depend, is not obvious. The Appellant respectfully requests that these rejections also be reconsidered and reversed.

2. Withdrawal of Claims 73, 84, and 85

The Office Action made Final also withdrew claims 73, 84, and 85 as being drawn to a non-elected invention. Claims 84 and 85 are dependent upon claim 73, and claim 73 is dependent upon claim 65. In the Office Action made Final, the Patent Office states that claims 73, 84, and 85 are not drawn to the election “made without traverse in the reply filed on 6/28/04.” In the response filed on June 28, 2004, in response to a restriction, the Appellant amended the then-pending claims and stated,

The Appellant believes that these claims may be drawn to the aspect that appears in Figure 9 of the subject application; however, the Appellant submits that these claims are not limited to the aspect of the invention shown in Figure 9.

Though not a formal election of species, for the sake of this proceeding, the Appellant elected the species of Figure 9 for subsequent prosecution. However, contrary to the comments made by the Patent Office, this election of the species of Figure 9 does not require the withdrawal of claims 73, 84, and 85.

First, and most significantly, claims 73, 84, and 85 are dependent claims, all ultimately introducing limitations to the invention recited in claim 65. Since claim 65 is drawn to the elected invention, claims dependent upon claim 65 are inherently drawn to the elected invention. Based upon this reasoning alone, the withdrawal of claims 73, 84, and 85 is inappropriate. The Appellant requests that this withdrawal be reversed.

Second, the limitations recited in claims 73, 84, and 85 are represented by and encompassed within the embodiment shown in Figure 9. In order to facilitate discussion, claim 73 is reproduced here in its entirety.

73. The sound system as recited in claim 65, further comprising at least one sound wave guide adapted to transmit sound waves from the at least one electronic speaker to the at least one sound emitting perforation in the head rest.

Clearly, claim 73 introduces the limitation to claim 65 that the sound system include at least one wave guide between the electronic speaker and the sound emitting perforation. The Appellant readily concedes that this aspect of the invention is not illustrated in Figure 9. However, as discussed above, Figures 8 and 9 are provided to illustrate representative aspects of the invention, and are not intended to limit the invention. For example, in paragraphs [0061] and [0062], the inventors disclose that, in Figures 8 and 9, "Head rest 229 also includes at least one, typically two, electronic or wave-guide-type speakers 244 as discussed previously." [0061: lines 7-9] and "The speaker 224 in this aspect can be an electronic speaker or a wave-guide-type speaker as discussed above..." [0062:6-8]. One of those previous discussions is presented in paragraph [0050] where the Appellant discloses, "...according to one aspect of the present invention, an electronic speaker may be located directly beneath or adjacent to speakers 42, 44, or, for example, positioned within the head rest 29 and emit audio sound waves that are transmitted by wave guides 58, 60, or wires and still be within the scope of the present invention." [0050:8-13, Emphasis added.] As shown, for example, in Figures 4B and 5B, wave guides 58 and 60 transmit sound to perforations 74 and 76 (mis-labeled 73, 75 in Figure 4B) in head rests 29 and 129. That is, though the subject matter of claim 73 is not illustrated in Figure 9, the subject matter of claim 73 is clearly encompassed within the species of the invention shown in Figure 9 and illustrated, for example, in Figures 4B and 5B.

Therefore, the Appellant respectfully requests that the withdrawal of claims 73, 84, and 85 be reconsidered and reversed.

Appellant: Gardenier, et al.
Appln. Serial No.: 10/621,749
Date of Appeal Brief: April 18, 2008


-22-

Attorney Ref.: 1442.033B

CONCLUSION

In conclusion, the Appellant submits that 1) the inventions recited in claim 65 and its dependents are not obvious in view of Ludlow and Kvalvik, and 2) claims 73, 84, and 85 should not be withdrawn from consideration in this proceeding. Therefore, the Appellant respectfully requests that the Office Action made Final be reversed in all respects.

Respectfully submitted,



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Dated: April 18, 2008

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CLAIMS APPENDIX

1-64. *(Cancelled)*

65. A sound system for a spa, the spa comprising a housing having an upper rim of substantially uniform elevation, the sound system comprising:

a head rest mounted on or below the upper rim so as not to substantially alter the substantially uniform elevation and adapted to support the head of an occupant of the spa, the head rest having at least one sound emitting perforation; and

at least one electronic speaker located below the upper rim of the housing, the at least one electronic speaker positioned to transmit sound through the at least one sound emitting perforation and having a speaker wire extending within the housing.

66. The sound system as recited in claim 65, further comprising a source of sound positioned within the housing and distal the at least one speaker for providing an audio signal to the at least one electronic speaker.

67. *(Cancelled)*

68. The sound system as recited in claim 65, wherein the at least one sound emitting perforation comprises a plurality of perforations.

69. The sound system as recited in claim 68, wherein the plurality of perforations comprises at least two sets of perforations.

70. The sound system as recited in claim 65, wherein the headrest comprises a resilient material.

71. *(Cancelled)*

72. *(Cancelled)*

73. The sound system as recited in claim 65, further comprising at least one sound wave guide adapted to transmit sound waves from the at least one electronic speaker to the at least one sound emitting perforation in the head rest.

74. The sound system as recited in claim 65, wherein the at least one electronic speaker comprises at least one marine-grade audio speaker.

75. *(Cancelled)*

76. *(Cancelled)*

77. The sound system as recited in claim 65, wherein the at least one electronic speaker is located directly beneath the at least one sound emitting perforation.

78. *(Cancelled)*

79. *(Cancelled)*

80. The sound system as recited in claim 65, wherein the headrest is mounted to the spa housing wherein the substantially uniform elevation of the spa is unchanged.

Claims 81-83. *(Cancelled)*

84. The sound system as recited in claim 73, wherein the sound wave guide comprises one of a cavity and a chamber.

85. The sound system as recited in claim 84, wherein the sound wave guide comprises one of a cavity and a chamber in the spa housing.

Claims 86-91. (*Cancelled*)

92. The sound system as recited in claim 65, wherein the at least one speaker is positioned one of beneath and within the head rest.

93. The sound system as recited in claim 65, wherein the sound system does not negatively effect the shipping requirements of the spa.

94. The sound system as recited in claim 65, wherein the sound system does not increase dimensions of the spa.

Appellant: Gardenier, et al.
Appln. Serial No.: 10/621,749
Date of Appeal Brief: April 18, 2008

-26-

Attorney Ref.: 1442.033B

EVIDENCE APPENDIX

NONE

Appellant: Gardenier, et al.
Appln. Serial No.: 10/621,749
Date of Appeal Brief: April 18, 2008

-27-

Attorney Ref.: 1442.033B

RELATED PROCEEDINGS APPENDIX

NONE